

REMARKS / ARGUMENTS

The present application includes pending claims 1-41, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0001386, issued to Akiyama (hereinafter, Akiyama), in view of U.S. Patent No. 6,073,237, issued to Ellison (hereinafter, Ellison). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

I. The Proposed Combination of Akiyama and Ellison Does Not Render Claims 1-41 Unpatentable

The Applicant turns to the rejection of claims 1-41 as being unpatentable over Akiyama in view of Ellison. The Applicant notes that the proposed

combination of Akiyama and Ellison forms the basis for all of the pending rejections.

A. Independent Claims 1, 11, 21, and 32

With regard to the rejection of independent claim 1 under 103(a), the Applicant submits that the combination of Akiyama and Ellison does not disclose or suggest at least the limitation of "encrypting the digitally signed secure key utilizing at least a previously generated unreadable digitally signed encrypted key," as recited by the Applicant in independent claim 1.

The Examiner concedes the following in the Office Action:

Akiyama discloses encrypting work keys with master key. Akiyama does not disclose that the master key is also encrypted and digitally signed as now required by claim limitation.

However, using PKI system to encrypt and digitally signing the keys are well known technique in the art of cryptography, which enable secure transmission of keys over unsecured channels using asymmetric key encryption. Ellison, in the same field of endeavor of network security, discloses encrypting and digitally signing a key (Column 4, lines 64-67, "The session key K_x is signed by private key of the server itself K_n 121 and encrypted by the public key of the user P1e. The encrypted and signed session key K_x is then sent back to the user 123).

See the Office Action at pages 3-4. The Applicant points out that the relevant claim limitation from Applicant's claim 1 is "encrypting the digitally signed secure key utilizing at least a previously generated unreadable digitally signed encrypted key". In other words, **a digitally signed secure key is encrypted by**

utilizing a digitally signed encrypted key that has been previously generated and it is unreadable.

The Examiner relies on Ellison for support and is apparently equating the session key K_x of Ellison to Applicant's "secure key". Ellison further discloses that the session key K_x is signed by a private key of the server and then **encrypted by the public key of the user P1e**. In other words, Ellison encrypts the signed secure key by simply using a public key. The Applicant points out that it is well known in the art of asymmetric cryptography, that the public key is widely distributed. In this regard, **the public key of the user P1e is not "unreadable"**, as recited in Applicant's claim 1. Furthermore, **the public key disclosed by Ellison is also not a digitally signed and encrypted key that has been previously generated**.

Therefore, the Applicant maintains that the combination of Akiyama and Ellison does not disclose or suggest at least the limitation of "encrypting the digitally signed secure key utilizing at least a previously generated unreadable digitally signed encrypted key," as recited by the Applicant in independent claim 1.

Accordingly, the proposed combination of Akiyama and Ellison does not render independent claim 1 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 1 is allowable. Independent claims 11, 21, and 32 are similar in many respects to the method

disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 21, and 32 are also allowable over the references cited in the Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 2-10, 12-20, 22-31, and 33-41

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11, 21, and 32 under 35 U.S.C. § 103(a) as being unpatentable over Akiyama in view of Ellison has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-10, 12-20, 22-31, and 33-41 depend from independent claims 1, 11, 21, and 32, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-10, 12-20, 22-31, and 33-41.

CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-41 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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